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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,614	02/21/2001	Fabio Gozzi	33829W002	4565

7590

09/27/2006

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Sao Paulo,  
BRAZIL

EXAMINER
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ANTHONY, JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/788,614

Applicant(s)

GOZZI

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/06/2006 as amendment.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Brazil on 02/25/2000. It is noted, however, that applicant has not filed a certified copy of the Brazil application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are indefinite because the actual chemical makeup of component:

*Mineral oil (SAE 15W/40API-CF4/CF CE/SS)* is unclear since it is unknown what "CF4/CF CE/SS" stands for. It should be noted that applicant's originally filed specification has not set forth what "CF4/CF CE/SS" stands for.

Claims 1-3 are indefinite in regards to component depropylen glycol (methylen chloride). The examiner after an extensive search in the following data bases: USPT, USOC, PGPB, Chemical Abstracts and the Registry filed in STN can find NO hits to the actual existence of a compound named depropylen glycol (methylen chloride). The examiner also searched said compound using many different spellings such as depropylene glycol (methylene chloride), depropylene glycol (methylene dichloride),

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depropylene glycol (dichloromethane), dipropylene glycol (methylene chloride), dipropylene glycol (methylene dichloride), dipropylene glycol (dichloromethane), etc., and found NO hits to the existence of such a compound. The examiner is thus totally confused if such a compound actually exists at all. Applicant is thus required to prove that depropylen glycol (methylen chloride) is a compound that actually exists. In addition, a structural formula of the compound should be submitted along with other common spelling/names for the compound.

Claims 1-3 are indefinite in regards to the listed concentration ranges since they lack units such as (by weight, by volume, or by mass). Applicant is advised not to add new matter into the claims and/or the specification when addressing this rejection so as to avoid a future new matter rejection.

Claims 1-3 are indefinite because the claims use a very uncommon spelling for the component tetrachlorethylene, which may in fact be a misspelling. Far more common spellings for said component is tetrachloroethylene and/or perfluoroethylene.

### ***Claims Free of Prior-Art Rejections***

4. Claims 1-3 are free of any prior-art rejections, at least in part, because the examiner cannot find any composition that actually comprises depropylen glycol (methylen chloride) [(i.e. dipropylene glycol (methylene chloride)?] in it. Such is not surprising since the examiner is also unable to find any evidence that the compound depropylen glycol (methylen chloride) [(i.e. dipropylene glycol (methylene chloride)?] actually exists; see section 3 above for details. Furthermore, even ignoring the issue of

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depropylen glycol (methylen chloride) [(i.e. dipropylene glycol (methylene chloride)?], the examiner can find no prior-art references that teach or suggest a composition comprising a mixture of tetrachloroethylene, mineral oil (SAE 15W/40API) and methyl cellulose carboxy (i.e. carboxymethylcellulose). There is certainly no disclosure of any kind to applicant's particularly claimed concentration ranges for said components that make up the claimed compositions.

The prior-art cited on the PTO-892 does make it clear that it is very well known in the prior-art to use tetrachloroethylene (i.e. perfluoroethylene) as a high dielectric solvent in electrical insulation compositions, see U.S. Patent Numbers 4,293,433, 4,745,966, 4,790,337, 4,697,043, and 4,415,629. Furthermore, Denger U.S. Patent Number 3,046,160, directed to a process for treating paper with silicones, does teach liquid compositions that comprise in part carboxymethyl cellulose and perchloroethylene (see Examples 6-9), but such components are used at concentrations far below that which are claimed by applicant in claims 1-3.

#### ***Prior-Art Cited But Not Applied***

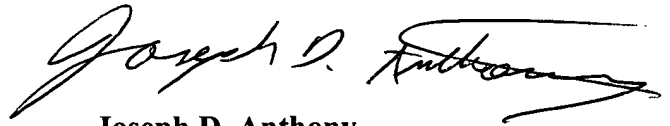
5. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

#### ***Examiner Information***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number

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is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
**Art Unit 1714**

9/23/06